

REMARKS

I. Introduction

Claims 1-61 were pending in this application.

Claims 34-61 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 32 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-3, 14-18, 20, 26, 27, 34-36, 47-51, 53, 59, and 60 were rejected under 35 U.S.C. § 102(b) as being anticipated by Graves et al. U.S. Patent No. 5,830,067 (hereinafter "Graves").

Claims 4-13, 19, 21-25, 29-33, 37-46, 52, and 54-58 were rejected under 35 U.S.C. § 103(a) as being obvious from Graves and Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner").

II. Summary of Applicants' Reply

Applicants have amended claims 1, 29, 32, 34-50, and 52-61 to more particularly define the invention. Claims 18 and 51 have been canceled without prejudice. Claims 62-67 have

been added. The new and amended claims are fully supported by the specification and therefore do not add new matter.

The Examiner's rejections are respectfully traversed.

III. Applicants' Reply to the § 101 Rejection

Claims 34-61 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. According to the Office Action, the preambles of these claims recite "a machine-readable medium" and this type of medium "is not necessarily a computer readable medium and . . . directed to functionally descriptive material that is not functionally or structurally interrelated to the medium." See Office Action, page 3.

Although applicants disagree that claims 34-61 are not directed toward statutory subject matter, in order to advance prosecution, applicants have amended the references to "machine-readable medium" to recite "computer-readable medium." Applicants submit that claims 34-61 now recite material that is functionally and structurally interrelated to the computer-readable medium. Applicants respectfully request, therefore, that the rejection of these claims under 35 U.S.C. § 101 be withdrawn.

IV. Applicants' Reply to the § 112 Rejection

Claim 32 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. According to the Office Action, claim 32 is written in "single means claim" format that recites only one element to perform all the functions recited in the claim. See Office Action, pages 3-4. The Examiner relies on the decision in *Fiers v. Revel*, 25 U.S.P.Q.2d 1601 (Fed. Cir. 1993), for supporting the rejection. Applicants respectfully traverse this rejection.

Applicants initially note that claim 32 does not recite only one element to perform all the claimed functionality, as the Office Action contends. Rather, claim 32 recites both "user television equipment" and a "transaction processing and subscription management system." The user television equipment is configured to provide the interactive wagering application and automatically place the wager while the transaction processing and subscription management system is configured to handle the automatically placed wager. This is in contrast to the DNA structure in *Fiers* where the applicant attempted to claim all DNA structures that achieved a

particular result. *See Fiers* at 1606. Claim 32 recites an interactive wagering system involving both user television equipment and a transaction processing system. These two devices are configured in a particular way to work together to achieve a desired result - namely, automatically providing a notification to the user and placing a wager when certain conditions are met. Applicants respectfully request, therefore, that the 35 U.S.C. § 112, first paragraph, rejection be withdrawn.

V. Applicants' Reply to the Prior Art Rejections

The pending claims were rejected either under 35 U.S.C. § 102 as being anticipated by Graves or under 35 U.S.C. § 103 as being obvious from Graves and Brenner.

Applicants' claimed invention is directed toward systems, methods, and computer-readable media for interactive wagering with an interactive wagering application implemented using user equipment. A user is allowed to use the interactive wagering application to select desired wagering criteria or a given horse. Racing data is received about a plurality of races. It is then determined whether a desired wagering opportunity exists or the horse is to run in a race by

comparing at least a portion of the received racing data to the wagering criteria or an identification of the horse. The interactive wagering application is then used to automatically take a particular action in response to determining that a desired wagering opportunity exists or the horse is to run, wherein the particular action comprises at least providing a notification to the user that the desired wagering opportunity exists or the horse is to run in at least one race.

Graves refers to an electronic or mechanical device that acts as an automated agent enabling clients to participate in games (e.g., bingo games) without being present at the site of the game. See Graves, Abstract, col. 2, lines 31-59. In one embodiment of Graves, the CPU may "query the client as to his preference of how he wants to make any necessary strategic decisions" about playing the game. See Graves col. 4, line 62 - col. 5, line 3. This information may then be saved to the player's preference file, and the proxy player machine may then automatically make certain decisions based on the data in each player's preference file. See Graves, col. 5, lines 3-21.

Although Graves' proxy playing machine may make some strategic decisions on behalf of the player while the machine is playing a game, neither Graves nor Brenner automatically

provide a notification to the user in response to determining that a desired a wagering opportunity exists or a selected horse is about to run in a race. Various summary and reporting notifications may be sent to the player in Graves, but these notifications only include replicas of the game cards actually in play or the results of the game. See Graves, col. 5, lines 46-48 and col. 6, lines 15-21. At no time is a notification automatically provided to the user in response to determining that a desired wagering opportunity exists or a horse is about to run.

For at least the foregoing reasons, applicants submit that claims 1-17, 19-50, and 52-61 are allowable over the combination of Graves and Brenner. Applicants respectfully request, therefore, that the 35 U.S.C. 102 and 103 rejections be withdrawn.

VI. New Claims 62-67

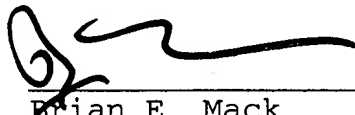
New claims 62-67 specify additional features of the invention. For example, claims 62 and 66 recite that the user may place a wager in response to the notification, and claims 63-65 and 67 recite that the notification is provided at

substantially the same time as the determination is made that the desired wagering opportunity exists or the horse is to run in the at least one race. These claims, which depend from one of allowable independent claims 1, 29, 32, or 34, are allowable for at least the same reasons as their respective independent claim.

VII. Conclusion

In view of the foregoing, claims 1-17, 19-50, and 52-67 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



Brian E. Mack
Reg. No. 57,189
Agent for Applicants
ROPES & GRAY LLP
Customer No. 75563
1211 Avenue of the Americas
New York, New York 10036-8704
Tel.: (212) 596-9000
Fax: (212) 596-9090